

REMARKS

Claim 1 has been amended in this response. No new matter has been added by this response.

Claims 1-34 are currently pending in this application.

Claims Rejections – 35 USC § 102

(A) Claims 1-5, are rejected under 35 U.S.C. 102(a) as being anticipated by E.P. Patent No. 1,208,862 to Newby et al. (“Newby”).

This rejection is respectfully traversed with respect to the amendment to claim 1.

Of the claims rejected, claim 1, is independent, with the remaining claims dependent thereon.

Amended Claim 1 recites, among other things:

*a lock for releasably maintaining the shield in the fully retracted position;
an actuator for releasing the lock; and
a retaining member engageable with the shield,
wherein upon activation of the actuator and release of the lock, the shield engages the retaining member, and wherein the shield is prevented from moving to the fully extended position until the retaining member is disengaged from the shield.*

Applicant submits that Newby fails to disclose at least the claimed features of: a retaining member distinct from a provided lock, where, upon release of the lock, the retaining member prevents deployment of the safety shield to the fully extended shielded position until that retaining member is itself disengaged.

Newby discloses a safety needle assembly, incorporating a telescoping shield that extends over the distal end of the needle cannula when released by an actuator. In particular, when the actuator is triggered the telescoping shield extends to contact the skin of a patient (See Fig. 4) and /or to the fully extended and locked position over the distal end of the needle cannula (See Figs 5 and 9).

In contrast, the shield of the present application does not advance to the fully extended position upon activation of lock release as it is held by the retaining member, such that the

retaining member has to be released in order for the shield to advance to the fully extended position.

The Examiner is of the opinion that Newby discloses a shieldable needle assembly comprising a retaining member (57) engageable with the shield. Applicant respectfully submits that retention rib (57) of Newby is part of the locking mechanism which retains the telescoping shield (3) in the retracted position (See paragraph [0023], Figs 3 and 7 shown below, emphasis added).

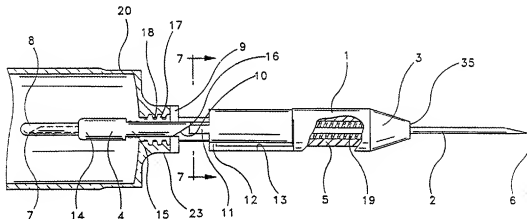


FIG. 3 Newby

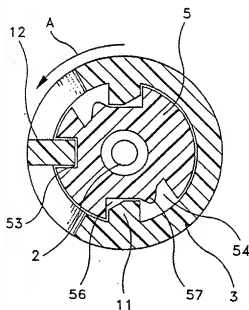


FIG. 7 Newby

[0023] Fig. 7 is a cross-sectional view of needle assembly 1 shown in Fig. 3 at its starting retracted position along lines 7-7. As shown in Fig. 7, tab 12 of torsion spring 13 is located in torsion spring track 53 in needle hub 5 and each shield lug 11 is located in a respective proximal pocket 56. Each of these lugs 11 are held in each pocket 56 by a respective retention rib 57. When closure 51 is penetrated by distal end 7 of cannula 2 and sleeve 14 on actuator 4 causes distal lateral movement of actuator 4 and mating of surfaces 10 and 16, shield 3 is rotated in the direction of arrow A and lugs 11 move over retention ribs 57 into their respective channels 54. Once lugs 11 are in their respective channel 54, compression spring 19 causes distal movement of shield 3 until it reaches the partially extended position shown in Fig. 4.

Therefore the retention rib (57) of Newby does not prevent the advancement of the shield after activation of the actuator (4).

Thus claim 1, and dependent claims 2-5, are not anticipated by the Newby reference.

Double Patenting Rejections

Claims 1-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of US Patent No. 6,984,223 to Newby et al. ("Newby 223").

Claims 1-34 are provisionally rejected on the ground of nonstatutory obviousness type double patenting as being unpatentable over claims 1, 5, 6, and 9-24 of copending US Patent Application No. 10/309,904 to Swenson ("Swenson").

In each rejection the Examiner alleges that although the conflicting claims are not identical, they are not patentably distinct from each other.

These rejections are respectfully traversed.

Of the claims rejected, claims 1, 19, 22 and 27 are independent with the remaining claims dependent thereon.

Claims 1, 19, 22 and 27 of the present application are patentably distinct from the claims of the cited references.

Both Newby 223 and Swenson have no disclosure or suggestion of a retaining member distinct from a primary lock which prevents deployment of the safety shield to the fully extended shielded position upon release of the lock that maintains the safety shield in its retracted position.

As noted above, in Newby, a single lock is provided and the claimed telescoping shield in Newby 223 is designed to advance to the fully extended locked position automatically on release of such lock.

Similarly Swenson teaches a spring based pivoting needle shield that is retained by a single retaining member (lock) in a retracted position and is designed to advance to the fully extended locked position automatically on release of such a lock.

In contrast, in the present invention, as defined by claims 1, 19, 22 and 27, the telescoping shield is designed not to advance to the fully extended locked position on release of such lock, but has a retaining member that prevents such deployment.

Therefore the present invention, as defined by claims 1, 19, 22 and 27 is patentably distinct when compared to the claims of the Newby 223 and Swenson references.

CONCLUSION

In view of the amendment and remarks herein, applicant submits the claims are patentably distinct over the prior art and allowable in form.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment to Deposit Account No. 02-1666.

If the Examiner has any questions or comments relating to the present application, he or she is respectfully invited to contact applicants' agent at the telephone number set forth below.

Respectfully submitted,

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